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HARMAN - BRINKS HOFER CHICAGO
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago IL 60610

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OFFICE OF PETITIONS

In re Application of :
DAVID H. GRIESINGER : LETTER REGARDING
Application No. 10/810,989 : PATENT TERM ADJUSTMENT
Filed: March 26, 2004 :
Attorney Docket No. 11336-699 :
(P02056US U3C) :

This letter is in response to the "REQUEST FOR REVIEW OF PATENT TERM ADJUSTMENT," filed October 31, 2008. Pursuant to applicant's duty of good faith and candor to the Office, applicant requests that the determination of patent term adjustment under 35 U.S.C. 154(b) be reviewed for accuracy.

The request for review of the initial Determination of Patent Term Adjustment is GRANTED.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance is 316 days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On August 8, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment was 346 days. On October 31, 2008, applicant submitted the instant comment.

Applicant requests that the Office recalculate the period of patent term adjustment. Applicant does not state a basis for

applicant's disagreement with the according of 346 days of patent term adjustment.

A review of the application history confirms that applicant should have been assessed a delay under 37 CFR 1.704(c)(8) for the submission of Information Disclosure Statements on October 29, 2007, and November 16, 2007.

37 CFR 1.704(c)(8) provides:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

It is undisputed that after filing a response on October 17, 2007, applicant filed Information Disclosure Statements on October 29, 2007 and November 16, 2007. The record does not support a conclusion that the examiner expressly requested the Information Disclosure Statements. Further, a review of the Information Disclosure Statements, filed October 29, 2007 and November 16, 2007, reveal that applicant did not include a proper statements under 37 CFR 1.704(d).¹ Thus, applicant failed to engage in reasonable efforts to conclude prosecution of the application.

¹ Pursuant to 37 CFR 1.704(d):

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Pursuant to 37 CFR 1.704(c)(8), a first period of reduction of 12 days should have been entered, counting the number of days beginning on the day after the date the initial reply was filed, October 18, 2007, and ending on the date that the IDS was filed, October 29, 2007. See 37 CFR 1.704(c)(8). Pursuant to 37 CFR 1.704(c)(8) a second period of reduction of 30 days should have been entered, counting the number of days beginning on the day after the date the initial reply was filed, October 18, 2007, and ending on the date that the second IDS was filed, November 16, 2007.

37 CFR 1.704(c) provides that "[c]ircumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application ... will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping." The first period of reduction of 12 days pursuant to 37 CFR 1.704(c)(8) totally overlaps with the second period of reduction of 30 days. Accordingly, a single period of reduction of 30 days is being entered for these two periods of reduction.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is **316 days** (476 days of Office delay - 160 days of applicant delay).

As this letter was submitted as an advisement to the Office of an error in applicant's favor, the Office will not assess the \$200.00 fee as set forth in 37 CFR 1.18(e). The Office thanks applicant for applicant's good faith and candor in bringing this to the attention of the Office.

Applicant is reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicant will be notified in the Issue Notification letter that is mailed to applicant approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

Kery A. Fries

Kery A. Fries
Senior Legal Attorney
Office of Patent Legal Administration

Enclosure: Copy of updated PAIR screen